

#12

Beiersdorf 658-HCL
6713-Dr. Wi-ka

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANTS : SCHREINER et al.
SERIAL NO. : 09/701,710
FILED : 1 December 2000
FOR : COSMETIC OR DERMATOLOGIC PREPARATIONS CONTAINING
CATECHINS OR GREEN TEA EXTRACTS
ART UNIT : 1619
EXAMINER : Alysia Berman

21 November 2002

Group Director – Technology Center 1610
ATTN: John Doll
Hon. Commissioner of Patents and Trademarks
Washington, D.C. 20231

PETITION UNDER 37 CFR § 1.181
(Prematurity of Final Rejection – MPEP § 206.07(c))

SIR:

Please accept this petition against the holding of finality of the Office Action dated 9 October 2002.

CONDITIONAL PETITION FOR EXTENSION OF TIME

If entry and consideration of the amendments above requires an extension of time, Applicants respectfully request that this be considered a petition therefore. The Assistant Commissioner is authorized to charge any fee(s) due in this connection to Deposit Account No. 14-1263.

ADDITIONAL FEE

Please charge any insufficiency of fees, or credit any excess, to Deposit Account No. 14-1263.

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REMARKS

The applicants received an Office action dated 9 October 2002 which included a new grounds of rejection which was:

- (1) not necessitated by applicant's amendment; and
- (2) was based on a reference which was not submitted by the applicants in the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

Rejection based on PI 9303217-0 A is a new grounds of rejection

The examiner's previous art based rejections under 102(b) and 103(a) were withdrawn in favor of a new 103(a) rejection of currently pending claims 5-12 and 26 using the PI 9303217-0 A. This reference was neither used as part of a rejection in the examiner's first office action nor was it disclosed in her notice of references cited (PTO Form-892) attached to the first office action.

As can be seen from the applicants' amendment of 8 March 2002, the amendments made to the claims narrowed the scope of the claimed subject matter. Moreover, the weight range limitation inserted into claim 5 was also used in the claim 22 as filed in the preliminary amendment. MPEP 904.04 (General Search Guidelines) states that "The search should cover the claimed subject matter and should also cover the disclosed features which might reasonably be expected to be claimed." Since the original claims were broader in scope than the claims as amended, the scope of prior art from the original search should have been unaffected by the amendments made to the claims.

The PI 9303217-0 A reference also was not submitted by the applicants in the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

Additional Comment About Status of Information Disclosure Statement

It appears that there is some confusion as to the nature of the references which are listed as being considered by the examiner. Upon further review of the application, it appears that the examiner did in fact consider the references which were cited in the international search report which was submitted in an IDS (i.e. WO 98/10739; DE 196 27 344 and the English abstract for DE 196 27 344). The IDS was signed by the examiner on 4 December 2001 (part of Paper No. 6).

However, the examiner also attached to Paper No. 6 an IDS which was for SN: 09/701,719 which lists Youngdae Kim as an inventor. This IDS is not part of the applicants invention (see also the differences in

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the Docket Numbers) and as such is being returned by the applicants so that this paper can be matched with the proper application. The applicants request that the examiner remove any copies of this IDS from the present file.

Closing

The applicants believe the application of the PI 9303217-0 A reference constitutes a new grounds of rejection and respectfully request that the finality of the previous office action be withdrawn.

Respectfully submitted,

Norris, McLaughlin & Marcus, P.A.

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HCL:vif

Attachment: Misfiled IDS for SN: 09/701,719

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that the foregoing Petition Under 37 CFR § 1.181 (3 pages total) is being facsimile transmitted to the United States Patent and Trademark Office on the date indicated below:

Date: 21 November 2002

By: Vilma I. Fernandez
Vilma I. Fernandez

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GROUP 1600**OFFICIAL****Date:** 21 November 2002**To:** Examiner Alysia Berman
US Patent and Trademark Office
Tel. 703-308-4638
Fax: 703-746-4977
703-305-3704
or 703-305-4556**Subject:** USSN 09/701,710
Our Ref.: Beiersdorf 688**From:** Howard C. Lee**Comments:** Filing of Petition Under 37 CFR § 1.181 (3 pgs.), enclosing Misfiled IDS for 09/701,719 (1 pg.).

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